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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,496	01/02/2001	Jeffrey H. Sherman	AVISTA/209-1016	2163

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EXAMINER
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NGUYEN, TAM M

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/753,496	Applicant(s) SHERMAN ET AL.	
	Examiner Tam M. Nguyen	Art Unit 1764	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4,6-9,11-13,15,16,18-28,30,31,33-38,40,41,43,45-51,53 and 60-67 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 50,51,53 and 60-63 is/are allowed.
- 6) ☒ Claim(s) 4,6-9,11-13,15,16,18-20,22-28,30,31,33-35,37,38,41,43,45-47,49 and 64-67 is/are rejected.
- 7) ☒ Claim(s) 21,36,40 and 48 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claim 64 is objected to because it depends on canceled claim 58. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 6, 11, 12, 18, 23, 24, 30, 38, 40, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/00928.

The WO 97/00928 reference discloses a process for refining used oil by contacting the oil with an alkaline base (e.g., sodium hydroxide) in the presence of ethylene glycol. The used oil mixture is then washed with water (solvent). Next, the used oil is separated from the water/contaminants to produce clean used oil which is further purified in a distillation zone. (See abstract; since the WO 97/00928 is equivalent to US Patent 6,072,065; see col. 3, lines 7-60; col. 4, lines 11-59; col. 5, lines 1-15)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1764

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-9, 13, 15, 16, 19-20, 22-28, 31, 33-35, 37, 43, 45-47, 49, and 64-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/00928

The WO 97/00928 reference discloses a process for refining used oil by contacting the oil with an alkaline base (e.g., sodium hydroxide) in the presence of ethylene glycol. The used oil mixture is then washed with water (solvent) in an extractive zone. Next, the used oil is separated from the water/contaminants to produce a clean used oil which is further purified in a distillation

zone. (See abstract; since the WO 97/00928 is equivalent to US Patent 6,072,065, see col. 3, lines 7-60; col. 4, lines 11-59; col. 5, lines 1-15 of the US Patent)

The reference does not disclose the distillation column conditions. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of WO 97/00928 by using the claimed conditions because the reference discloses that the conditions are selected to obtain desired fractions. Therefore, one of skill in the art would select any conditions including the claimed conditions which would produce desired product.

The reference does not disclose the amount of base or glycol. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of WO 97/00928 by using any amounts of base and glycol including the claimed amounts because WO 97/00928 does not limit the amount. Therefore, one of skill in the art would employ any amount of base and glycol that is effective to remove contaminants from the oil and it would be expected that the results would be similar when using the claimed amounts in the process of WO 97/00928.

***Allowable Subject Matter***

Claims 50, 51, 53, and 60-63 are allowed.

Claims 21, 36, 40, and 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:  
The primary reason for allowance is that no prior art of record discloses or suggests a method for removing contaminants from used oil wherein the oil is contacted with a glycol in the presence of an inorganic base compound and the oil mixture is then mixed with N, N-dimethylformamide to dissolve contaminants from the used oil.

### *Response to Arguments*

The argument that Chavet discloses a process for removing contaminants from base oils not used motor oil and the distillate contains only 60 % of used oil is not persuasive because Chavet discloses that used oil is distilled before contacting with solvent and a part of the whole distillate from the distillation step can be processed in the contacting step, so the distillate used in the contacting step is a used oil. In addition, the claimed process does not exclude other steps and does not specify the composition of the claimed used oil. (See col. 3, lines 43-44)

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam M. Nguyen whose telephone number is (571) 272-1452. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tam M. Nguyen  
Examiner  
Art Unit 1764

TN

  
Glenn Caldarola  
Supervisory Patent Examiner  
Technology Center 1700